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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,143	07/23/2001	Hidenori Wada	10873.772US01	4482

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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT PAPER NUMBER

2655

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/911,143	<b>Applicant(s)</b> WADA ET AL.	
	<b>Examiner</b> Jorge L Ortiz-Criado	<b>Art Unit</b> 2655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16-20,23,24 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) 16-20,23,24 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/01,11/03,01/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group II claims 27-31 in the reply filed on 11/15/2004 is acknowledged.
2. Claims 16-20, 23, 24 and 32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/15/2004.

### ***Information Disclosure Statement***

The information disclosure statements filed on 12/12/01, 11/17/2003 and 01/03/05 have been considered and made of record.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The abstract of the disclosure is objected to because does not states concisely the technical disclosure of the invention to which the claims are directed. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 27-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, new claim 27, recites that the optical recording medium comprises two or more recording layers on which information is recorded and a distance from one of the plurality of recording layers to a surface of the optical recording medium is approximately 100 $\mu$ m(0.1mm). The examiner cannot readily ascertain/map where in the specification as originally filed such a disclosure/support is found. The dependent claims fail to clarify the above and fall accordingly.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 27-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 recites the limitation "the plurality of recording layers" in line 6 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

**As far as the claims recite positive limitations, the following art rejections are made.**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 27-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Kashiwagi U.S. Patent No. 6,175,548.

Regarding claim 27, Kashiwagi discloses an optical recording medium with respect to which information is recorded or reproduced using a light source emitting light with a wavelength of 390 nm to 420 nm and an optical head including an objective lens with a NA of 0.7 to 0.9, wherein the optical recording medium comprises two or more recording layers on

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which information is recorded and a distance from one of the plurality of recording layers to a surface of the optical recording medium is approximately 100 $\mu$ m (See Abstract, col. 1, line 59 to col. 2, line 36; col. 3, line 64 to col. 4, line 41; Figure 2)

Regarding claim 28, Kashiwagi discloses comprising no more than two recording layers (See Fig.2)

Regarding claim 29, Kashiwagi discloses wherein a distance from the surface of the optical recording medium to a first recording layer is approximately 100 $\mu$ m, and a distance from the surface of the optical recording medium to a second recording layer is larger than 100 $\mu$ m (See Fig. 2, col. 2, line 36; col. 3, line 64 to col. 4, line 41)

Regarding claim 31, Kashiwagi discloses wherein administrative information of the optical recording medium is recorded at a position of approximately 100 $\mu$ m from the surface of the optical recording medium (" the information is recorded in the **recording layer** at a position of approximately 100 $\mu$ m (See col. 2, line 36; col. 3, line 64 to col. 4, line 41)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kashiwagi U.S. Patent No. 6,175,548.

Kashiwagi discloses that wherein a distance from the surface of the optical recording medium to a first recording layer is approximately 100 $\mu$ m, and a distance from the surface of the optical recording medium to a second recording layer is larger than 100 $\mu$ m and wherein the distance relationship from the surface of the optical recording medium to the first and the second recording its larger or smaller to approximately 100 $\mu$ m. (See col. 2, line 36; col. 3, line 64 to col. 4, line 41)

It would have been obvious of matter of design choice to modify the Kashiwagi by having a distance from the surface of the optical recording medium to a second recording layer smaller than 100  $\mu$ m since applicant has not disclosed that having the specific smaller distance to the second recording layer solves any sated problem or is for any particular purpose.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. patent No. 5,972,459 to Kawakubo et al. and U.S. Patent No. 6192022 to Hendriks et al., which discloses an optical recording medium with respect to which information is recorded or reproduced using an optical head including an objective lens with a NA of 0.7 to 0.9, wherein the optical recording medium comprises two or more recording layers on which information is recorded and a distance from one of the

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plurality of recording layers to a surface of the optical recording medium is approximately 100 $\mu$ m

b. (1)U.S. Patent No. 6,246,656 to Kawakubo et al. and (2) U.S. Patent Application Publication No. 2002/0012257, which discloses an optical recording medium with respect to which information is recorded or reproduced using a light source emitting light with a wavelength of 390 nm to 420 nm and an optical head including an objective lens with a NA of 0.7 to 0.9, wherein the optical recording medium comprises two or more recording layers on which information is recorded and a distance from one of the plurality of recording layers to a surface of the optical recording medium is approximately 100 $\mu$ m.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L Ortiz-Criado whose telephone number is (703) 305-8323. The examiner can normally be reached on Mon.-Thu.(8:30 am - 6:00 pm),Alternate Fridays off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris H To can be reached on (703) 305-4827. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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